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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,912	06/27/2006	Masahiro Sasagawa	1806.1012	1640

21171 7590 10/02/2009
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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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10/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/556,912	Applicant(s) SASAGAWA ET AL.	
	Examiner WALTER B. AUGHENBAUGH	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/29/06, 7/12/07</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (USPN 6,166,143) in view of Masubuchi (JP 2001-019827) (abstract included in Sept. 29, 2006 IDS, translation of Detailed Description section included with this Office Action).

In regard to claims 1, 3 and 6, Watanabe et al. teach a hose comprising a substrate layer comprising a fibrous material, an adhesive layer and a thermoplastic elastomer layer (see, for example, col. 16, lines 35-60). The composition of Watanabe et al. has improved compatibility and has a sufficient heat resistance, oil resistance, flexibility, and low compression set and oil resistance for hoses (col. 2, lines 63-67).

Watanabe et al. fail to teach the recited mixture of polymers as the material of the thermoplastic elastomer layer.

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Masubuchi, however, disclose a thermoplastic elastomer composition that is suitable as the thermoplastic elastomer composition of a hose and of parts of appearance that corresponds to the claimed mixture of polymers that has excellent crack-proof property, pliability, the low-temperature characteristic, weatherability, intensity, and molding workability (see, for example, paragraphs 0043, 0006-0019 of translation). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the thermoplastic elastomer composition of Masubuchi as the thermoplastic elastomer composition of the hose of Watanabe et al. since the composition of Masubuchi has properties that are desirable for hoses such as pliability, the low-temperature characteristic and weatherability as taught by Masubuchi.

To the extent that Masubuchi does specifically teach any of the recited properties, these characteristics would be inherent in the composition: the composition of the reference is composed of the same components that are recited, so the skilled artisan would expect the inherent physical characteristics to be the same, as well, since there is nothing otherwise recited that would lead to a different result.

In regard to claim 2, Masubuchi teach that the composition includes a rubbery polymer that corresponds to the claimed rubber (see, for example, paragraph 0023). Although Masubuchi does specifically teach the recited glass transition temperature and any other properties not specifically taught, these characteristics would be inherent in the composition: the composition of the reference is composed of the same components that are recited, so the skilled artisan would expect the inherent physical characteristics to be the same, as well, since there is nothing otherwise recited that would lead to a different result.

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In regard to claims 4 and 5, although Watanabe et al. and Masubuchi do not specifically teach the claimed adhesive, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a given adhesive composition in order to achieve the desired adhesive properties depending on the particular desired end result, and to have selected a particular adhesive in order to achieve the desired properties of the hose depending on the particular desired end result. The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945); *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious); MPEP 2144.07.

In regard to claim 7, although Watanabe et al. and Masubuchi do not specifically teach that the thermoplastic elastomer composition is foamed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a given thermoplastic elastomer composition such as a foamed thermoplastic elastomer composition in order to achieve the desired adhesive properties (such as density, flexibility, thermal insulation, etc...) depending on the particular desired end result, and to have selected a particular thermoplastic elastomer composition in order to achieve the desired properties of the hose (such as density, flexibility, thermal insulation, etc...) depending on the particular desired end result. The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945); *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to

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make a container of a type made of plastics prior to the invention was held to be obvious); MPEP 2144.07.

In regard to claims 8-12, although Watanabe et al. and Masubuchi do not specifically teach that the laminate is used as any of the articles recited in claims 8-12 (although Masubuchi does teach that the material is used as interior parts of a car [paragraph 0043]), it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the laminate in any application in which a rubbery surface is commonly used, such as any of the articles recited in claims 8-12, because the material taught by Masubuchi for the laminate taught by Watanabe et al. and Masubuchi is a rubbery material that is also excellent for “parts of appearance” (paragraph 0043).

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 7:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Walter B Aughenbaugh /

Examiner, Art Unit 1794

9/30/09